U.S. DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
FILED
JUL 27 2006
CLERK, U.S. DISTRICT COURT
By ____________
Deputy

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
LUBBOCK DIVISION

TEXAS TECH UNIVERSITY,	)	
Plaintiff/Counter-Defendant,	)	
	)	
v.	)	**CIVIL ACTION No. 5-05CV0192-C**
	)	
JOHN SPIEGELBERG, Individually, and	)	
d/b/a RED RAIDER OUTFITTER	)	
Defendant/Counter-Plaintiff	)	

PLAINTIFF'S MOTION AND BRIEF TO DISQUALIFY COUNSEL

TEXAS TECH UNIVERSITY ("Texas Tech"), Plaintiff in the above-entitled and numbered case, files this Motion and Brief to Disqualify Counsel. Mr. Erik J. Osterrieder is counsel for JOHN SPIEGELBERG, D/B/A RED RAIDER OUTFITTER ("RRO"), Defendant in this action.

I. Introduction.

Texas Tech intends to call Erik J. Osterrieder as a witness to testify to RRO's alleged ownership of the trademarks "RAIDERLAND" and "WRECK 'EM TECH" and the validity of RRO's applications to register these marks with the United States Patent and Trademark Office ("USPTO"). RRO, in its pleadings, claims ownership of the marks "RAIDERLAND" and "WRECK 'EM TECH"[1] and, therefore, RRO's alleged ownership of these trademarks and the validity of the applications to register these trademarks are at issue in this case.[2] Mr. Osterrieder, under penalty

1 *See* Defendant's Answer, Defenses, and Counter-Claims, page 17 of 35, filed 03/27/2006.

2 On July 20, 2006, Texas Tech opposed the application to register the mark WRECK 'EM TECH in a proceeding before the USPTO Trademark Trial and Appeal Board. A true and correct copy of the Notice of Opposition is attached as Exhibit A.

of perjury, signed, on behalf of RRO, the applications to register the contested trademarks. In the applications to register the marks "RAIDERLAND" and "WRECK 'EM TECH," he swore as follows:

> The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.
>
> Signature: /Erik J. Osterrieder/ Date: 04-30-2005 [3]

In his deposition, the defendant, Mr. Spiegelberg, however, never confirms ever authorizing Mr. Osterrieder to file the application to register the mark RAIDERLAND.

> Q.: Did you sign that ["RAIDERLAND"] application?
> A.: I don't remember.
> Q.: Did you authorize your attorney to file the application?
> A.: I don't remember, to be frank with you.[4]

When asked whether he was aware that he claims exclusive ownership of the "RAIDERLAND" mark, Mr. Spiegelberg stated, "I'm not familiar with this. I have not seen it, so I really don't know.

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3 *See* Oral Deposition of John Spiegelberg, June 21, 2006, Exhibit 10, Trademark Application No. 78620435, Declaration, 4/30/2005.

4 Oral Deposition of John Spiegelberg, June 21, 2006, Page 61, Line 14.

And I can't elaborate on it."[5]

Mr. Spiegelberg made similar remarks with regards to the "WRECK 'EM TECH" mark.

Q.: Did you authorize the filing of the application that has been marked as Exhibit 10?
A.: Not to my knowledge, that I can remember of.[6]

When asked about the declaration Mr. Osterrieder signed, attesting to his knowledge that no other "person, firm, corporation, or association" would have a claim to the marks, Mr. Spiegelberg again made it clear that he was not aware of Mr. Osterrieder's actions.

Q.: Do you know whether this is truthful, that no other person, firm, corporation, or association, other than yourself, can use the phrase Wreck 'Em Tech?
A.: I don't know
Q.: Did you authorize Mr. Osterrieder to sign the declaration on your behalf?
A.: I don't know.
Q.: You don't remember ever doing that?
A.: No, I don't remember. Like I said, the legal – everything goes through my son. He takes care of that.
Q.: But his name is not on the application, is it?
A.: Correct.
Q.: It's your name?
A.: Correct.
Q.: And you're the applicant of – you're the one seeking to register Wreck 'Em Tech and Raiderland, correct?
A.: Correct.[7]

Based on the defendant's testimony, it is apparent that Mr. Spiegelberg and Mr. Osterrieder did not have a clear understanding regarding the applications to register the marks RAIDERLAND

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5 Oral Deposition of John Spiegelberg, June 21, 2006, Page 62, Line 24.

6 Oral Deposition of John Spiegelberg, June 21, 2006, Page 74, Line 17.

7 Oral Deposition of John Spiegelberg, June 21, 2006, Page 76, Line 24.

and WRECK 'EM TECH, contrary to the declarations that Mr. Osterrieder signed when he filed these applications. Because it was Mr. Osterrieder and not Mr. Spiegelberg who signed the declarations in support of the applications to register the marks WRECK 'EM TECH and RAIDERLAND, Mr. Osterrieder's testimony at trial will be necessary in order to address the validity of the applications to register the marks RAIDERLAND and WRECK 'EM TECH and RRO's alleged ownership of these marks. This dual role as advocate and witness is inappropriate and is likely to create confusion for the jury.[8]

II. The ABA Model Rules of Professional Conduct Prohibit an Attorney from Continuing to Represent a Client if He Knows He Could Become a Fact Witness in the Proceeding.

The ABA Model Rules of Professional Conduct provide that an attorney may not continue employment for a client in a proceeding if he knows that he could become a fact witness in that proceeding, unless:

(1) the testimony relates to an uncontested issue;

(2) the testimony relates to the nature and value of legal services rendered in the case; or

(3) disqualification of the lawyer would work substantial hardship on the client.[9]

Both national and state ethical rules govern the Court's evaluation of cases involving

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8 *Anderson Producing Inc. v. Koch Oil Co.*, 929 S.W.2d 416, 422 (Tex. 1996).

9 ABA Model Rule 3.7 (2002); *see also* TEX. GOV'T CODE ANN., art. 10 § 9, Rule 3.08(b) (Vernon 2004).

disqualification of an attorney.[10] "When reviewing the disqualification of an attorney, [the Court] must 'consider the motion governed by the ethical rules announced by the national profession in the light of the public interest and the litigant's rights.'"[11] The Texas Rules are also relevant "because they govern attorneys practicing in Texas generally, and because the Northern District Rules contain language virtually identical to the state canon."[12] These standards are not exactly the same,[13] however, case law sheds light on their application.

Both Texas and Federal cases have applied this rule to situations where clients' attorneys become potential witnesses in trials. For example, the Texas Supreme Court in *Mauze v. Curry* found an abuse of discretion where the trial court did not dismiss a plaintiff's attorney who signed and swore to the only affidavit controverting the defendant's motion for summary judgment in a legal malpractice case.[14] The Northern District of Texas and Fifth Circuit have also applied this rule to situations where attorneys have become witnesses in proceedings.[15] Because Mr. Osterrieder

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10 *See F.D.I.C. v. US Fire Ins. Co.*, 50 F.3d 1304, 1311-12 (5th Cir. 1995) (citing *In re American Airlines, Inc.*, 972 F.2d 605, 605 (5th Cir. 1992)).

11 *Id.* at 1312 (citing *In re Dresser Industries, Inc.*, 972 F.2d 540, 543 (5th Cir. 1992)).

12 *Id.*

13 *Id.*

14 *See Sanders v. Squier*, 1995 WL 739691 at 2 (Tex. App. – Houston 1995) (citing *Mauze v. Curry*, 861 S.W.2d 869 (Tex. 1993)).

15 *See F.D.I.C.*, 50 F.3d at 1318 (5th Cir. 1995); *Wooley v. Sweeney*, 2003 WL 21488411 at 3 (N.D. Tex. 2003).

made factual representations under penalty of perjury regarding Mr. Spiegelberg's ownership and exclusive rights to the marks RAIDERLAND and WRECK 'EM TECH, he has become a material fact witness in this case.

On July 19, 2006, counsel for Texas Tech advised Mr. Osterrieder of Texas Tech's intent to call him as a fact witness in this case and provided Mr. Osterrieder the opportunity to withdrawal as counsel.[16] In response, Mr. Osterrieder alleged that he was authorized to sign the applications to register the marks RAIDERLAND and WRECK 'EM TECH by Stephen Spiegelberg, the son of the defendant in this case. Mr. Osterrieder offered the Declaration of Stephen J. Spiegelberg, which states that Stephen Spiegelberg authorized Mr. Osterrieder to file the trademark applications at issue.[17] Despite Stephen Spiegelberg's alleged third-party authorization, Mr. Osterrieder is the only witness who can testify to the validity of the applications to register the marks RAIDERLAND and WRECK 'EM TECH filed by John Spiegelberg d/b/a Red Raider Outfitter because Mr. Osterrieder was the signatory on these applications. Moreover, Mr. Osterrieder's testimony will be essential to the determination of why these applications were filed on behalf of the defendant in this case rather than Stephen Spiegelberg.

III. As a Material Fact Witness in this Proceeding, Mr. Osterrieder Must be Disqualified from Representing RRO.

Texas and Federal Courts have found that an attorney serving as a fact witness in a

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16 A true and correct copy of Mr. Henn's July 19, 2006 letter is attached as Exhibit B.

17 A true and correct copy of Mr. Osterrider's July 21, 2006 letter and the Declaration of Stephen J. Spiegelberg are attached as Exhibit C.

proceeding is valid grounds for disqualification of that attorney.[18] In order to disqualify opponent's counsel, the moving party must prove that the attorney's testimony will regard an essential fact and must demonstrate that the attorney's dual roles as lawyer and witness will cause the movant actual prejudice.[19] Comment 4 to Rule 3.08 states that when a lawyer's "testimony concerns a controversial or contested matter, combining the roles of advocate and witness can unfairly prejudice the opposing party.[20] Mr. Osterrieder's testimony regarding the validity of the applications to register the marks RAIDERLAND and WRECK 'EM TECH, and RRO's alleged ownership of these marks, goes to the heart of the subject-matter of this case and, therefore, would be considered essential facts. Furthermore, his testimony regarding this matter will unfairly prejudice Texas Tech.

IV. Prayer for Relief.

WHEREFORE, Plaintiff prays that this matter be set for hearing and that on final hearing the Court rule that Erik J. Osterrieder is disqualified from continuing to serve in this matter, and order him to withdraw from representation, and further prays for such other and further relief as movant may merit.

18

See F.D.I.C., 50 F.3d at 1318, and *Sanders v. Squier*, 1995 WL 739691 at 2 (citing *Bert Wheeler's, Inc. v. Ruffino*, 666 S.W.2d 510 (Tex. App. – Houston [1st Dist.] 1983, orig. proceeding) and *United Pac. Ins. Co. v. Zardenetta*, 661 S.W.2d 244 (Tex. App. – San Antonio 1983, orig. proceeding)).

19

F.D.I.C., 50 F.3d at 1317; In *re Sanders*, 153 S.W.3d 54, 57 (Tex. 2004).

20

ABA Model Rule 3.7, Comment 1 (2002); *see also* TEX. GOV'T CODE ANN., art. 10 § 9, Rule 3.08, Comment 4 (Vernon 2004).

Dated: July 27, 2006

Respectfully submitted,

JONES, FLYGARE, BROWN & WHARTON
A Professional Corporation

James L. Wharton
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ATTORNEYS FOR PLAINTIFF

CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of **PLAINTIFF'S MOTION TO DISQUALIFY COUNSEL** was served on Defendant John Spiegelberg, d/b/a Red Raider Outfitter, through his attorney of record, Mr. Erik J. Osterrieder, *via First Class Mail, certified, RRR* in an envelope addressed to:

Mr. Erik J. Osterrieder
Schubert Osterrieder & Nickelson PLLC
6013 Cannon Mtn. Dr., S14
Austin, TX 78749

James Gorsuch
Attorney at Law
4412 74th Street, Suite B-102
Lubbock, TX 79424

Dated: July 27, 2006

By: ______________________
James L. Wharton
State Bar No. 21243500
JONES, FLYGARE, BROWN & WHARTON
P.O. Box 2426
Lubbock, Texas 79408
Telephone: (806) 765-8851
Facsimile: (806) 765-8829

CERTIFICATE OF CONFERENCE

This is to certify that Eric Osterrieder was presented with Texas Tech intent and concern expressed in this Motion on July 19, 2006 and Mr. Osterrieder refused to disqualify and is opposed to the Motion.

____
James L. Wharton

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
LUBBOCK DIVISION

TEXAS TECH UNIVERSITY, **Plaintiff/Counter-Defendant,** **v.** **JOHN SPIEGELBERG, Individually, and d/b/a RED RAIDER OUTFITTER** **Defendant/Counter-Plaintiff**	))))))))	**CIVIL ACTION No. 5-05CV0192-C**

APPENDIX TO PLAINTIFF'S MOTION AND BRIEF TO DISQUALIFY COUNSEL

R. CHARLES HENN, JR.
ALICIA GRAHN JONES
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COUNSEL FOR PLAINTIFF
TEXAS TECH UNIVERSITY

Table of Contents to Appendix

Notice of Opposition - In the United States Patent and Trademark Office Before the Trademark Trial and Appeal Board Texas Tech University v. John Spiegelberg d/b/a Red Raider Outfitter in the matter of Application Serial No. 78/620,435 Mark: Wreck 'Em Tech .... Exhibit A (1-13)

Letter to Erik Osterrieder from R. Charles Henn dated July 19, 2006 .... Exhibit B (14-15)

Letter to Kilpatrick Stockton from Erik Osterrieder dated July 21, 2006 .... Exhibit C (16)

Declaration of Stephen J. Spiegelberg .... Exhibit C (17)

CERTIFICATE OF SERVICE

A true and correct copy of Appendix to Plaintiff's Motion and Brief to Disqualify Counsel was sent on this the 27th day of July, 2006 to the following counsel:

Erik J. Osterrieder, Attorney-in-Charge
Schubert Osterrieder & Nickelson, PLLC
6013 Cannon Mtn. Dr., S14
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Alicia Grahn Jones
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Attorney at Law
4412 74th Street, Suite B-102
Lubbock, TX 79424

James L. Wharton

Exhibit "A"

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TEXAS TECH UNIVERSITY,	)	
	)	
Opposer,	)	In the matter of Application
	)	
v.	)	Serial No. 78/620,435
	)	Mark: WRECK 'EM TECH
	)	
	)	
JOHN SPIEGELBERG d/b/a RED	)	
RAIDER OUTFITTER,	)	
	)	
Applicant.	)	

NOTICE OF OPPOSITION

Opposer Texas Tech University is a general academic teaching institution of the State of Texas, having its principal location at 2500 Broadway, Lubbock, Texas 79409 ("Opposer"). Opposer believes it will be damaged by the registration of the mark WRECK 'EM TECH (Serial No. 78/620,435), and opposes the same pursuant to 15 U.S.C. § 1063, and 37 C.F.R. §§ 2.101 and 2.104(a). Application Serial No. 78/620,435 is currently at issue in a case between the parties pending before the United States District Court for the Northern District of Texas and, therefore, Opposer is filing a Motion to Suspend Proceedings concurrently with this Notice of Opposition.[1] The ground for the opposition are as follows.

1. On information and belief, on June 27, 2006, Applicant John Spiegelberg d/b/a Red Raider Outfitter ("Applicant") filed an application to register the mark WRECK 'EM TECH (Serial No. 78/620,435) ("Applicant's Mark") for use in connection with "clothing and accessories, namely shirts, pants, jackets, shorts, sweat bands, sweat suits, socks, and hats" in

[1] Opposer's Motion to Suspend Proceedings is attached as Exhibit A.

International Class 25. Applicant's trademark was first published for Opposition in the Official Gazette dated June 27, 2006. Thus, Opposer has timely filed this Notice of Opposition.

2. Texas Tech University ("TTU") was founded in 1923, and its academic and athletic programs are well known and respected across the Untied States. TTU has extensively used and promoted "Texas Tech University" and "Texas Tech" as its name, as well as a trademark and service mark.

3. TTU owns a federal registration for the mark TEXAS TECH UNIVERSITY (Reg. No. 2,511,970) for use in connection with "clothing, namely, shirts, sweatsuits, sweat shirts, sweat pants, t-shirts, caps, hats, jackets, and coats" in International Class 25 and "educational services, namely providing courses of instruction at the university level, and arranging and conducting educational conferences and academic exhibitions; and entertainment services, namely arranging and conducting athletic competitions, athletic tournaments, exhibitions, live performances, and festivals" in International Class 41, registered on November 27, 2001, claiming a date of first use of September 1, 1969.

4. A very common shorthand for referring to TTU is "Tech." In the appropriate context and circumstances, use of the term "Tech" will be perceived by the relevant consuming public as a reference to TTU. TTU's licensees have often used the moniker "Tech" as a means of referring to TTU, TTU's accomplishments, or events in which TTU will be participating.

5. TTU has used the mark WRECK 'EM TECH in connection with its fight song for at least sixty (60) years. A copy of TTU's fight song is attached as Exhibit B. TTU has also licensed use of the WRECK 'EM TECH mark in connection with various goods, including clothing. Opposer's TEXAS TECH UNIVERSITY, TECH, and WRECK 'EM TECH marks are collectively referred to as "Opposer's Marks."

6. As a result of TTU's longstanding and extensive use, Opposer's Marks are symbolic of the extensive goodwill and consumer recognition established by TTU. By virtue of TTU's expenditure of substantial amounts of time, effort and money in advertising and promoting its goods and services under Opposer's Marks, Opposer's Marks have come to identify TTU's athletic and other goods and services.

7. Opposer will be damaged by the registration of Applicant's Mark because the mark and its associated goods so resemble Opposer's Marks and the associated goods and services as to be likely to cause confusion, mistake and deception. Applicant's Mark contains the term "TECH" which is a reference to TEXAS TECH UNIVERSITY. Moreover, Applicant's Mark was derived from Opposer's fight song.

8. Persons familiar with Opposer's Marks are likely to believe erroneously that Applicant's goods are offered by TTU or are authorized, licensed, endorsed or sponsored by TTU, and registration of Applicant's Mark on the Principal Register will be inconsistent with Opposer's rights in the Opposer's Marks.

9. Applicant's applied-for mark also falsely suggests a connection with TTU, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

10. Registration of Applicant's Mark would cause dilution to the distinctiveness of Opposer's Marks by eroding consumers' exclusive identification of these famous marks with Opposer, tarnishing and degrading the positive associations and prestigious connotations of the marks, and otherwise lessening the capacity of the marks to identify and distinguish the goods and services of Opposer.

11. Registration of Applicant's Mark should be refused because the application is being procured by fraud. Specifically, either Applicant knows or should have known that: (1)

Opposer is the owner of the WRECK 'EM TECH mark, (2) Applicant is not entitled to use the WRECK 'EM TECH mark in commerce; (3) Opposer has the right to use the WRECK 'EM TECH mark in commerce.

12. On information and belief, Applicant's attorney was acting on behalf of Applicant without his authority when Applicant's counsel filed the application to register the mark WRECK 'EM TECH. In related litigation, when asked whether Applicant authorized the application to register Applicant's Mark, Applicant responded "Not to my knowledge, that I can remember of."

13. Enclosed is the PTO-2038 authorizing the credit card payment of the $300.00 filing fee.

WHEREFORE, Opposer requests that Application Serial No. 78/620,435 be refused registration and this Notice of Opposition be sustained in favor of Opposer.

Respectfully submitted,

Alicia Grahn Jones

R. Charles Henn Jr.
Alicia Grahn Jones
KILPATRICK STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, Georgia 30309-4530
(404) 815-6500

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Commissioner of Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on 7/20/06.

By: *Alicia Grahn Jones*
Alicia Grahn Jones

US2000 9399041 1

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TEXAS TECH UNIVERSITY, Opposer, v. JOHN SPIEGELBERG d/b/a RED RAIDER OUTFITTER, Applicant.	In the matter of Application Serial No. 78/620,435 Mark: WRECK 'EM TECH

OPPOSER'S MOTION TO SUSPEND PROCEEDINGS PURSUANT TO 37 C.F.R. § 2.117(a)

Opposer, Texas Tech University respectfully requests that the Board suspend proceedings in this Opposition pursuant to 37 C.F.R. § 2.117(a). As discussed in further detail in Opposer's Brief in Support, Opposer has filed a civil action in the United States District Court for the Northern District of Texas which will dispose of the issues raised in this opposition proceeding. Therefore, Registrant respectfully submits that this opposition proceeding should be suspended pending disposition of the civil action.

Dated: 7/20/06

Respectfully submitted,

Alicia Grahn Jones

R. Charles Henn Jr.
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Commissioner of Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on 7/20/06.

By: [signature]
Alicia Grahn Jones

CERTIFICATE OF SERVICE

I hereby certify that the foregoing has been served on Applicant's counsel by depositing a true and correct copy thereof with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Erik J. Osterrieder, Schubert Osterrieder & Nickelson PLLC, 6013 Cannon Mtn. Dr., S14, Austin, Texas 78749 on 7/20/06.

By: [signature]
Alicia Grahn Jones

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TEXAS TECH UNIVERSITY,	)	
	)	
Opposer,	)	In the matter of Application
	)	
v.	)	Serial No. 78/620,435
	)	Mark: WRECK 'EM TECH
	)	
	)	
JOHN SPIEGELBERG d/b/a RED	)	
RAIDER OUTFITTER,	)	
	)	
Applicant.	)	

OPPOSER'S BRIEF IN SUPPORT OF ITS MOTION TO SUSPEND

Opposer, Texas Tech University ("TTU") respectfully requests that the Board suspend proceedings in this Opposition pursuant to 37 C.F.R. § 2.117(a).

I. BACKGROUND

On June 27, 2006, Applicant John Spiegelberg d/b/a Red Raider Outfitter ("Applicant") filed an application to register the mark WRECK 'EM TECH (Serial No. 78/620,435), which is the subject of this opposition proceeding.[1]

On August 24, 2005, TTU filed a civil action against Applicant alleging trademark infringement and dilution, unfair competition, breach of contract, and related causes of action under state law (the "Civil Action").[2] The Civil Action will address several issues including TTU's rights in the WRECK 'EM TECH mark. The Civil Action was filed in the United States District Court for the Northern District of Texas where Applicant resides. Thus, Petitioner can claim no prejudice or burden stemming from litigation in this forum. The Civil Action will dispose of the issues raised in this opposition, and TTU therefore seeks suspension of these proceedings.

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[1] TTU's Notice of Opposition is being filed concurrently with this Motion to Suspend.

[2] TTU's complaint against Applicant is attached as Exhibit A.

Applicant notes that Cancellation No. 92044727 filed by Applicant, which concerns TTU's Registration No. 2,433,675 for the Raider Red Design mark, was suspended on January 13, 2006 pending disposition of the Civil Action.

II. ARGUMENT

The Board has the power to suspend proceedings in favor of a pending civil action pursuant to 37 C.F. R. § 2.117(a), which provides:

> Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

This Board regularly has exercised this power in the interests of promoting judicial economy and conserving resources. See Vining Indus., Inc. v. Libman Co., 1996 TTAB LEXIS 455, at *6 (T.T.A.B. July 16, 1996) (suspending Board proceedings "in the interest of judicial economy and consistent with [the Board's] inherent authority to regulate [its] proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion"); Tokaido v. Honda Assocs., Inc., 179 U.S.P.Q. 861, 862 (T.T.A.B. 1973) ("[N]otwithstanding the fact that the Patent Office proceeding was the first to be filed, it is deemed to be the better policy to suspend proceedings herein until the civil suit has been finally concluded."); Townley Clothes, Inc. v. Goldring, Inc., 100 U.S.P.Q. 57, 58 (Comm'r Pat. 1953) ("[I]t would not seem to be in the interests of 'judicial economy' for the parties to proceed in two forums. . . .").

This opposition should be suspended because proceedings in the Civil Action will conclusively determine TTU's rights in the WRECK 'EM TECH mark, and therefore will be dispositive of all issues raised in this proceedings. See Tokaido v. Honda Assocs., Inc., 179 U.S.P.Q. at 862 ("[W]hile a decision of the District Court would be binding upon the Patent Office, a decision by the Trademark Trial and Appeal Board would only be advisory in respect to the disposition of the case pending in the District Court."); see also Sam S. Goldstein Indus., Inc. v. Botany Indus., Inc., 301 F. Supp. 728, 731, 163 U.S.P.Q. 442, 443 (S.D.N.Y. 1969) (noting that PTO "findings would not be res judicata in this [civil action]" and denying motion to stay district court proceedings).

III. CONCLUSION

For the foregoing reasons, TTU respectfully submits that this opposition proceeding should be suspended pending disposition of the Civil Action.

Dated: 7/20/06

Respectfully submitted,

Alicia Grahn Jones

R. Charles Henn Jr.
Alicia Grahn Jones
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Atlanta, Georgia 30309-4530
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CERTIFICATE OF MAILING

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By: Alicia Grahn Jones
Alicia Grahn Jones

CERTIFICATE OF SERVICE

I hereby certify that the foregoing has been served on Applicant's counsel by depositing a true and correct copy thereof with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Erik J. Osterrieder, Schubert Osterrieder & Nickelson PLLC, 6013 Cannon Mtn. Dr., S14, Austin, Texas 78749 on 7/20/06.

By: Alicia Grahn Jones
Alicia Grahn Jones

EXHIBIT B

Fight, Raiders, Fight! Fight, Raiders, Fight!
Fight for the school we love so dearly
You'll hit 'em high, you'll hit 'em low
You'll push the ball across the goal,
Tech, Fight! Fight!

We'll praise your name, boost you to fame
Fight for the Scarlet and Black
You will hit 'em, you will wreck 'em
Hit 'em! Wreck 'em, Texas Tech!
And the Victory Bells will ring out!

Written by Carroll McMath

Exhibit “B”

KILPATRICK
STOCKTON LLP
Attorneys at Law

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t 404 815 6500 f 404 815 6555
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CHenn@KilpatrickStockton.com

July 19, 2006

VIA FACSIMILE &
OVERNIGHT MAIL

Erik J. Osterrieder, Esq.
Schubert Osterrieder & Nickelson PLLC
1109 Gross Street
Houston, TX 77019

Re: *Texas Tech University v. John Spiegelberg, d/b/a Red Raider Outfitter*
Our Ref. No.: 49304/319796

Dear Erik:

As you know, ownership of the marks RAIDERLAND and WRECK 'EM TECH is an issue of fact in this case.

Your firm filed applications with the U.S. Patent and Trademark Office to register the marks RAIDERLAND and WRECK 'EM TECH in the name of John Spiegelberg. Mr. Spiegelberg, however, did not sign those applications. Instead, the factual representations made "under penalty of perjury" regarding Mr. Speigelberg's ownership and exclusive rights in the marks were signed by you. Moreover, Mr. Spiegelberg testified at his deposition that he did not authorize the filing of the applications and that he had no knowledge as to the truth of the factual representations made in the application. *See* Spiegelberg Dep. at 61-65; 73-77.

It thus appears that you have become a material fact witness in this case. Please provide us with dates on which you are available to be deposed during either the week of August 7 or August 21.

We also write to provide you with the opportunity to withdraw voluntarily as counsel for the defendant. Rule 3.08 of the Texas Rules of Professional Conduct states: "A lawyer shall not accept or continue employment as an advocate before a tribunal in a contemplated or pending adjudicatory proceeding if the lawyer knows or believes that the lawyer is or may be a witness necessary to establish an essential fact on behalf of the lawyer's client."

Erik J. Osterrieder, Esq.
July 19, 2006
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Please let us know within ten (10) days whether you will withdraw as counsel in this matter or if we will be forced to file a Motion to Disqualify.

Sincerely,

R. Charles Henn Jr.

cc: Larry Wharton
Jim Gorsuch

Exhibit "C"

Schubert
Osterrieder
Nickelson, PLLC

July 21, 2006

Kilpatrick Stockton LLP
1100 Peachtree Street, Suite 2800
Atlanta, GA 30309-4530

Only Via Email: CHenn@KilpatrickStockton.com, *and* AlJones@kilpatrickstockton.com

Re: ***TTU v. RRO*** – response to your July 19, 2006 letter
Cause No.: 5-05cv00192-C
Our file: RED.4061.LIT

Dear Charlie:

This letter responds to your July 19, 2006 letter that requests my response in regards to whether I will withdraw as attorney because you allege that I may be a material fact witness for the narrow issue of representations made to the USPTO for my clients' WRECK 'EM TECH and RAIDERLAND trademark applications. Further, your letter informs me that without my withdrawal, then you will be forced to file a motion to disqualify.

My response is that I will not withdraw because there is truly no need. Included with this letter is the Declaration of Stephen Spiegelberg, who, on behalf of the defendants and counter-plaintiffs in this case, provided me with both the authority and the factual representations necessary for me to file the above-referenced trademark applications. *See* Declaration of Stephen Spiegelberg. Furthermore, you have not yet deposed Stephen Spiegelberg, and, by doing so, you will immediately and easily find out, firsthand, that Stephen did provide me the authority and factual information for these above-referenced trademark applications. *Id.*

In addition and as you already know since you took John Spiegelberg's deposition, Stephen "has the approval of representing me on whatever we need." *See* Deposition of John Spiegelberg, p. 181. And, in further response to your questions about representations made to the USPTO, John also testified, "Like I said, the legal -- everything goes through my son. He takes care of that." *Id.*, pp. 76, 77, 100.

Based on the foregoing, I am not a material fact witness for establishing any essential fact in this case. For you to file a motion to disqualify me is not one after conducting a reasonable inquiry; instead, it would be one steeped in unreasonableness and vexation. Therefore, if you file a motion to disqualify me, then know now that we oppose it. We would respond and simultaneously cross-move with a motion for sanctions for your violations of both Rule 11(b) and 28 U.S.C. § 1927. Please consider this is our conference on that referenced motion for sanctions if you file a motion to disqualify me.

Very truly yours,
SCHUBERT OSTERRIEDER & NICKELSON PLLC

s/Erik J. Osterrieder

Erik J. Osterrieder

enc.: Declaration of Stephen J. Spiegelberg

cc: Jim Gorsuch; Stacey Barnes

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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
LUBBOCK DIVISION

TEXAS TECH UNIVERSITY, **Plaintiff, Counter-Defendant**	§ § §	
v.	§	**CIVIL ACTION No. 5-05cv00192-C**
JOHN SPIEGELBERG, individually, and **d/b/a RED RAIDER OUTFITTER** **Defendants, Counter-Plaintiffs**	§ § § § § §	

DECLARATION OF STEPHEN J. SPIEGELBERG

I, **Stephen J. Spiegelberg,** declare under penalty of perjury under the laws of the United States of America as follows:

1. I have personal knowledge of the facts which I state below, I am competent to give this testimony, and I am not disqualified to give testimony in court;
2. I am an employee and manager of daily operations of Red Raider Outfitter;
3. I am the son of the owner of Red Raider Outfitter, namely John Spiegelberg, who authorizes me to be in charge of Red Raider Outfitter;
4. I provided Erik J. Osterrieder with both the authority and the factual information he needed to draft and file U.S. trademark applications for RAIDERLAND and WRECK 'EM TECH on behalf of my father, John Spiegelberg and/or Red Raider Outfitter;
5. To any extent necessary, although such is not necessary in my opinion because Mr. Osterrieder acted with full authority and on factual information that I provided him, I retroactively and still authorize the U.S. trademark applications for RAIDERLAND and WRECK 'EM TECH that Mr. Osterrieder drafted and filed on behalf of my father, John Spiegelberg and/or Red Raider Outfitter, and
6. At my deposition, which has not yet occurred, I can answer all questions Plaintiff Texas Tech University has about factual representations made by Mr. Osterrieder, as well as his authorized acts, in regards to the two, aforementioned U.S. trademark applications that Mr. Osterrieder drafted and filed.

7/20/2006
Date

Stephen J. Spiegelberg